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| APPLICATION NO.               | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|---------------------|------------------|
| 10/564,403                    | 07/19/2006  | Heikki Seppa         | 0365-0664PUS1       | 1796             |
| 2292                          | 7590        | 09/29/2009           |                     |                  |
| BIRCH STEWART KOLASCH & BIRCH |             |                      | EXAMINER            |                  |
| PO BOX 747                    |             |                      |                     | HAUPT, KRISTY A  |
| FALLS CHURCH, VA 22040-0747   |             |                      | ART UNIT            | PAPER NUMBER     |
|                               |             |                      | 2876                |                  |
|                               |             |                      |                     |                  |
|                               |             |                      | NOTIFICATION DATE   | DELIVERY MODE    |
|                               |             |                      | 09/29/2009          | ELECTRONIC       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/564,403             | SEPPA, HEIKKI       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | KRISTY A. HAUPT        | 2876                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 July 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1 and 4-8 is/are rejected.  
 7) Claim(s) 2 and 3 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 13 January 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/06 and 4/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

This office action is in response to Application 10/564,403 filed 7/19/06. Claims 1-8 are pending with claims 1 and 8 in independent form.

### ***Priority***

This Application is a National Stage Application of PCT/FI04/00459 filed 7/16/04, which claims priority to Foreign Application FI 20031089 filed 7/17/03.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

4. Regarding claim 1, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Appropriate clarification and correction is required.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hiroaki JP 2002083752 (as cited by Applicant).

Hiroaki teaches:

With respect to claim 1, a method for identifying items, such as sheets of paper, packages or textiles in which the method includes:

- A mark made of electrically conductive material on the item is read contactlessly with the aid of a measurement of alternating electricity, in order to identify the item, or determine its properties (Abstract)
- Characterized in that the precise absolute or relative resistance value of one electrically conductive mark is determined and the resistance value is converted into information depicting the identity or properties of the item (Abstract)

3. Claims 1 and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartels US 5,159,181 (as cited by Applicant).

Bartels teaches:

With respect to claim 1, a method for identifying items, such as sheets of paper, packages or textiles in which the method includes:

- A mark made of electrically conductive material on the item is read contactlessly with the aid of a measurement of alternating electricity, in order to identify the item, or determine its properties (Abstract; Column 4, Lines 17-23, 25-27, 32-38 and 52-55; Column 5, Line 43 - Column 6, Line 20)
- Characterized in that the precise absolute or relative resistance value of one electrically conductive mark is determined and the resistance value is converted into information depicting the identity or properties of the item (Abstract; Column 4, Lines 17-23, 25-27, 32-38 and 52-55; Column 5, Line 43 - Column 6, Line 20)

With respect to claim 4 and incorporating all limitations of claim 1:

- The measurement is implemented by feeding an electrical field to the conductive mark with the aid of a first pair of electrodes and measuring the resistance value of the conductive mark with the aid of a second pair of

electrodes (Abstract; Column 4, Lines 17-23, 25-27, 32-38 and 52-55;  
Column 5, Line 43 - Column 6, Line 20)

With respect to claim 5 and incorporating all limitations of claim 1:

- A conductive ink is used as the material of the conductive mark (Column 6, Lines 14-19)

With respect to claim 6 and incorporating all limitations of claim 1:

- A conductive polymer is used as the material of the conductive mark (Column 6, Lines 14-19)

With respect to claim 7 and incorporating all limitations of claim 1:

- Part of the conductive mark is made by printing methods and part by output methods (Column 5, Line 43 – Column 6, Line 20)

With respect to claim 8, a reading system for a electrically conductive mark, which apparatus includes means for measuring impedance contactlessly:

- The system includes means for feeding alternating electricity measurement power contactlessly to one electrically conductive mark (Abstract)
- Means for determining a signal formed of the electrically conductive mark (Abstract; Column 4, Lines 17-23, 25-27, 32-38 and 52-55; Column 5, Line 43 - Column 6, Line 20)

- Means for determining the precise absolute or relative value of the resistance component of the single electrically conductive mark from this signal (Abstract; Column 4, Lines 17-23, 25-27, 32-38 and 52-55; Column 5, Line 43 - Column 6, Line 20)
- Means for decoding the resistance value of the single electrically conductive mark to form code information for the conductive mark (Abstract; Column 4, Lines 17-23, 25-27, 32-38 and 52-55; Column 5, Line 43 - Column 6, Line 20)

***Allowable Subject Matter***

4. Claims 2-3 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or fairly suggest to one of ordinary skill in the art, in conjunction with all the other limitations of the claims:

With respect to claim 2 and all its dependencies:

- A reference mark is read in connection with the measurement where the resistance value of the reference mark is compared with the resistance value of the mark depicting the properties or identity of the item, in conjunction with all other limitations of the claim and the claim from which it depends

The prior art of record fails to provide sufficient teaching or motivation to one of ordinary skill in the art to provide the additionally recited features of these claims in the combinations as claimed.

***Examiner's Note***

The Examiner has cited particular column and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the Applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the Prior Art or disclosed by the Examiner.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTY A. HAUPT whose telephone number is (571)272-8545. The examiner can normally be reached on M-F 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kristy A Haupt/  
Examiner, Art Unit 2876

/Michael G Lee/  
Supervisory Patent Examiner, Art Unit 2876